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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

68156755.5008

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on 11/2/05

Signature James H. Ortega

Typed or printed name James H. Ortega

Application Number

09/844,993

Filed

04/27/2001

First Named Inventor

Dreyband et al.

Art Unit

2166

Examiner

Channavajjala

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 50,554

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

James H. Ortega
Signature

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Telephone number

11/2/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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UTILITY PATENT APPLICATION
ATTY. DOCKET NO. 68156755.5008

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Applicant(s): Jacob Dreyband, *et al.*
Serial No.: 09/844,993
Filed: April 27, 2001
Title: DESCRIPTIVE DATA CONSTRUCT MAPPING METHOD AND APPARATUS
Group Art No.: 2166
Examiner: Srirama T. Channavajjala
Atty. Docket No.: 68156755.5008

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Dear Sir:

In response to the Final Office Action mailed August 2, 2005, Applicants submit the following Request for Pre-Appeal Brief Conference to review the final rejections in the above-identified patent application. Applicants note that the two-month deadline for filing a Notice of Appeal expires today, November 2, 2005. Thus, this Request and accompanying Notice of Appeal are timely.

REASONS FOR PRE-APPEAL BRIEF REVIEW

In response to an Office Action mailed December 23, 2004, (we believe this is Paper No. 15, although none of the Office Actions were marked with a Paper No. on them), the Applicants filed an Amendment on June 22, 2005. In this Amendment (Paper No. 16), the Applicants amended the claims to recite that the method for mapping a descriptive language comprises, among other things, “creating an executable object oriented class that is independently executable in any of a plurality of run-time environments and that corresponds to the identified complex-type element, ...” In the Final Office Action mailed August 2, 2005, the Examiner has again rejected independent claims 1, 9, 15, 23 and 29 under 35 U.S.C. §103(a) as allegedly obvious in view of the combination of the published article by Grady, *et al.* and U.S. Published Application No. 2002/0133811 to Duftler, *et al.* (it is noted that the Final Office Action initially stated that the above claims were rejected under the combination of Grady and Davidson, however, the Applicants believe it is clear from the discussion in the Office Action that the Examiner actually meant to cite Duftler in place of Davidson for this rejection). The Applicants respectfully assert that, based on the Examiner’s misinterpretation of the references on which the final rejections have been based, the Examiner has omitted one or more essential elements needed for a *prima facie* rejection under 35 U.S.C. §103(a).

A *prima facie* rejection under §103(a) has not been shown for at least two reasons. First, the Applicants respectfully assert that the combination of Grady and Duftler do not teach or suggest all of the elements of independent claims 1, 9, 15, 23 and 29. In the Office Action of December 23, 2004, the Examiner finally admitted that Grady does not teach a language having, among other things, an object oriented class that is independently executable in a run-time environment, but then cited Duftler for this missing element. (Paper No. 15, page 6, in response

to Applicants arguments in Paper No. 14, pages 11-12.) However, as argued in Paper No. 16, Duftler merely teaches a different means for creating JavaBeans to be executed in Java code such that the JavaBeans do not have to be individually encoded. (Paper No. 16, pages 11-12). But such code is still not independently executable in a run-time environment. The only executable language discussed in Duftler is Java, which is not independently executable in any of a plurality of run-time environments. Thus, the present claims provide for a universally executable object oriented language, as described in the present application, and is not limited to a single language implementation. The Applicants respectfully assert that this is a clear error by the Examiner in understanding not simply the teachings of the cited references, but the various areas of the technological field and their limitations.

A second reason a *prima facie* rejection under §103(a) has not been shown is that there is a lack of motivation to combine Grady with Duftler in order to assert the rejections. The mere fact that both references deal with innovations in related technology fields is alone not enough to demonstrate a motivation for one skilled in the art to combine the references. Specifically, the Applicants have pointed out to the Examiner that Grady teaches the use of XML Schema mapping to UML code, which is not executable in a run-time environment. On the other hand, Duftler only discloses the use of straightforward XML to define JavaBeans so that they do not have to be individually coded. (Paper No. 16, page 12.) Duftler does not teach or suggest the use of any Schema language in its approach. As a result, there is no motivation for one skilled in the art who is employing a Schema language, such as in Grady and in the present application, to combine the teachings in Duftler since Duftler merely teaches employing XML in a specific descriptive function. Moreover, there is nothing in Grady that suggests abandoning its technique for Schema mapping into UML in order to create JavaBeans as taught in Duftler. A specific

discussion of this distinction of Grady's Schema language and Duftler's XML code is found in Paper No. at pages 12-13. Consequently, the Applicants respectfully assert that this lack of motivation to combine is a clear error ripe for correction by a pre-appeal brief conference.

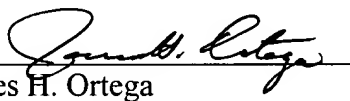
For at least these reasons, as well as the reasons set forth in prior Amendments, the combination of Grady with Duftler does not establish a *prima facie* rejection of independent claims 1, 9, 15, 23 and 29 under §103(a). Furthermore, the claims respectively depending from these independent claims also incorporate these distinctions, and are therefore also not obvious in view of Grady and Duftler. Accordingly, Applicants respectfully request that the Panel withdraw the §103 rejections, and allow the pending claims.

CONCLUSION

Applicants submit that the pending claims are in condition for allowance and request a Notice of Allowance for pending claims 1-36. The Panel is invited to contact the designated Attorney for Applicants, if needed. This Request is being filed concurrently with a Notice of Appeal, along with the appropriate fee of \$250 charged to Deposit Account No. 13-0480. If it is determined that additional fees are due, or an overcharge has occurred, please charge or credit Deposit Account No. 13-0480, referencing the Attorney Docket Number specified herein.

Respectfully submitted,

Date: 11/2/05


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